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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,544	11/12/2003	Linda S. Powers	13368.0001 (DIV. IV)	6901
7590	11/30/2004			
K. S. Cornaby Suite 1500 170 South Main Street Salt Lake City, UT 84101-1644			EXAMINER LUCAS, ZACHARIAH	
			ART UNIT 1648	PAPER NUMBER

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,544

Applicant(s)

POWERS ET AL.

Examiner

Zachariah Lucas

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) .<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Renumbered claim set</u> .               |

### **DETAILED ACTION**

1. Currently, there is one claim pending in the application.
2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 76 been renumbered claim 1.

#### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to methods for the capture of a bacteria on a substrate, classified in class 435, subclass 7.32.
  - II. Claim 1, drawn to methods for the capture of a virus on a substrate, classified in class 435, subclass 5.
  - III. Claim 1, drawn to methods for the capture of a rickettsiae on a substrate, classified in class 435, subclass 7.22.
  - IV. Claim 1, drawn to methods for the capture of a protozoa on a substrate, classified in class 435, subclass 7.22.
  - V. Claim 1, drawn to methods for the capture of a fungi on a substrate, classified in class 435, subclass 7.31.

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- VI. Claim 1, drawn to methods for the capture of a prion on a substrate, classified in class 435, subclass 7.1.
- VII. Claim 1, drawn to methods for the capture of a microbial protein target on a substrate, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

- 4. The inventions of Groups I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to methods for the capture of different target analytes. Each of these methods has a different mode of operation (requires the use of a ligand specific to the elected analyte), and performs a different function (the capture of a different analyte). The inventions are therefore distinct.

### *Species Election*

- 5. Restriction to one of the This application contains claims directed to the following patentably distinct species of the claimed invention:

The Applicant is required to elect one of species (A)-(G) representing ligands used to capture analytes.

Species (A)-(G) represent the elected invention wherein the ligand is:

- (A) a heme compound,
- (B) a siderophore,
- (C) a polysaccharide,
- (D) a peptides specific for an outer membrane protein,
- (E) a peptides specific for a conjugated lipid,
- (F) a peptides specific for a prion, and
- (G) a peptides specific for a microbial protein target.

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It is noted that, for the purposes of this action, the claim language “and peptides specific for outer membrane proteins, conjugated lipids prions, and microbial protein targets” identifying the ligand used in the claim is interpreted as indicating that the ligand may be a peptide that binds any of the listed targets (treating conjugated lipids and prions as separate targets). If this was not the Applicant’s intention, the Applicant is requested to clarify what was meant.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

*Examiner's Note*

6. It is noted that claim 1 purports to be drawn to a method for the capture of a biological analyte onto a substrate. However, it is also noted that the claims do not appear to recite any affirmative steps in the performance of this method. In view of this, absent amendment of the claim in response to this amendment, the claims will be rejected under 35 U.S.C. 112 ¶ 2 for indefiniteness as the claim does not set forth any steps to be performed in the claimed method.

7. It is further noted that claim 1 purports to include several uses for the claimed method. See, "steps" (e)-(k). However, although not setting forth actual steps to be performed, each of these steps is appears to be drawn to a separate embodiment of the claimed method. Yet, these different embodiments are all listed together as separate steps in the same method. It is therefore unclear what is being claimed. Absent amendment of the claim in response to this action, the claim will be rejected as indefinite because it is not clear whether the Applicant intends that all of these functions are to be performed simultaneously, or if the Applicant intended to list these as alternative embodiments.

*Conclusion*

8. Because these inventions are distinct for the reasons given above, have acquired a separate status in art because of recognized divergent subject matter and different classifications, and because the literature and sequence searches required for any one of the species is not required for the others, restriction for examination purposes as indicated is proper.

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9. It is here noted that some of the restrictions requirements made above fall within the scope of PTO Linking claim practice. In accordance with this practice as described in MPEP 809.03, linking claims will be considered with the elected invention. If the elected invention is found allowable, the linking claim will also be examined. If no substantive rejection is found for the linking claim, the restriction among the Groups it comprises will be withdrawn.

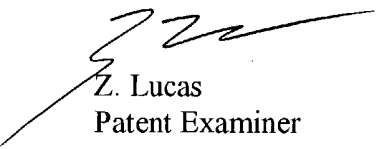
10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Z. Lucas  
Patent Examiner



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